

07-08-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Application : Serial **76-342,386** filed November 27, 2001 : by Samick Music Corporation : for the trademark :

"Samick"

2 ==

LAWRENCE MUSIC, INC.

Opposer,

v.

SAMICK MUSIC CORPORATION

Applicant.

: OPPOSITION NO. 91,156,310

: EXPRESS MAIL NO.: EU937887331US : Date: July 7, 2003

: I hereby certify that this paper : paper or fee is being deposited : with the United States Postal : Service "Express Mail Post Office

to Addressee" service under 37C.F.R. 1.10 on the date indicatedabove and is addressed to theAssistant Commissioner of

: Trademarks, 2900 Crystal Drive, : Arlington, VA 22202-3514 by:

: Gregg R. Zegarelli, Esq. : Attorney for Opposer

REPLY BRIEF TO APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR SUSPENSION OF PROCEEDINGS AND TO OPPOSER'S REQUEST FOR EXTENSION OF TIME TO OPPOSE FOR EXTRAORDINARY CAUSE

Opposer, Lawrence Music, Inc., by and through its counsel, hereby replies to Applicant's Opposition to Opposer's Motion to Suspend:

- 1. Applicant's entire argument side-steps the fundamental issue before the Board: whether the substantive issues in this opposition proceeding are being determined by a court of competent jurisdiction in a pending action? If so, then this proceeding should be stayed. The Board certainly has no interest in duplicating the Federal Government's judicial cost to determine legal rights, nor should anyone have an interest in creating additional expense to the parties or the witnesses.
- 2. The substantive issues in this opposition proceeding clearly are being fully and fairly litigated in the Federal District Court for the

7 IPrih 19 awronne Missin IndiGeneral Communitationaries CommissioniRenters Semick Commission to Motion to Stauray don

Western District of Pennsylvania. A copy of the relevant claim pleadings have been made of record in good faith and for the convenience of the Board.

- 3. Contrary to Applicant's argument, there is no testimony of record in this proceeding, and there are no admissions in the record. As required by law, Opposer has averred that it will be injured by the registration. Opposer has expressly stated, without limitation, that Applicant has abandoned the mark. If Opposer's averment is true, Opposer will be successful in the Federal District Court case and Applicant is not entitled to a registration. Whether Opposer's averment is true is one of the fundamental questions in the Federal District Court. (Applicant confuses the issue by arguing relative dates of use, even though relative dates of use are not part of the claim on an abandonment question.)
- 4. It is standard procedure for the Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues; in this case, they are the same issues. See McCarthy on Trademarks and Unfair Competition §32:47 (4th ed.).
- 5. Opposer ostensibly and unquestionably avers abandonment in the Seventh Affirmative Defense to its Reply to Counterclaim (of record herein). There are more than 400 exhibits identified by Opposer (as Plaintiff and Counter-Defendant) in its Pretrial Statement in the Federal District Court proceeding. Although Applicant is a multinational corporation and can apparently afford the additional duplicative costs, Opposer would be severely damaged by the duplicative costs.

WHEREFORE, Opposer, Lawrence Music, requests that this proceeding be stayed pending the determination in the aforesaid Federal District Court action. July 7, 2003

Respectfully submitted,

Gregg R. Zegarelli Esq Attorney for Opposer Lawrence Music, Inc.

ZEGARELLI
Technology & Entrepreneurial
Ventures Law Group, P.C.
Allegheny Building, 12th Floor
Pittsburgh, PA 15219-1616
412.765.0401
gregg.zegarelli@zegarelli.com

CERTIFICATE OF EXPRESS MAILING

& ·_ %

I hereby certify that the Reply Brief To Applicant's Opposition To Opposer's Motion For Suspension Of Proceedings And To Opposer's Request For Extension Of Time To Oppose For Extraordinary Cause, July 7, 2003, is being deposited with the United States Postal Service as U.S. Express Mail Number EU937887331US (under C.F.R. §1.8(a)), on this 7th day of July 2003, with sufficient postage and in an envelope addressed to:

Commissioner of Patents and Trademarks
Box 5, Attn: TTAB
2900 Crystal Drive
Arlington, VA 22202-3514, USA

And by depositing the same with the U.S. Mail, via regular mail, with sufficient postage, in an envelope addressed to:

Daniel M. Cislo, Esq. Cislo & Thomas, LLP 233 Wilshire Boulevard, Suite 900 Santa Monica, CA 90401-1211

Gregg R. Zegarelli, Esg.

71Phth19 awanne Missin IndiGeneral ComoratelTradement Connection(Renty to Semint Connection to Motion to Statute don





07-08-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22



Writer's Direct Information grz@zegarelli.com 412.765.0401

July 7, 2003

VIA EXPRESS MAIL
Airbill No. EU937887331US

Assistant Commissioner of Trademarks Box 5, Attn: TTAB 2900 Crystal Drive Arlington, VA 22202-3514

Re:

"Samick"

Serial No.: 76/342286

Dear Trademark Trial and Appeal Board:

Kindly find enclosed a Reply Brief to Applicant's Opposition to Opposer's Motion for Suspension of Proceedings and to Opposer's Request for Extension of Time to Oppose for Extraordinary Cause.

Thank you for your attention in this regard; please call me if you have any questions.

Very truly yours,

ZEGARELLI

Technology & Entrepreneurial

Ventures Law Group; P.C.

Gregg R. Zegarelli, Esq.

Enclosure · ·

cc. Lawrence Music, Inc.

(with enclosure)

ALLEGHENY BUILDING, 12™ FLOOR • 429 FORBES AVENUE • PITTSBURGH, PA 15219•1616, USA VOICE 412.765.0400 • WWW._EGARELLL.COM • FACSIMILE 412.765.0531 CHICAGO • PITTSBURGH • WASHINGTON, D.C.